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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/488,079
Filing Date: January 20, 2000
Appellant(s): MONTAGUE, DAVID R.

A. John Pate
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 11/30/2005 appealing from the Office action mailed 2/7/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,153,842	Dlugos	10-1992
2001/003041	Redford	6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos Sr. et al (5,153,842) in view of Redford et al (US2001/0003041).

Claims 1, 11, 18, and 24: Dlugos discloses a method and apparatus for attaching product labels comprising:

- a. Affixing a label to a product surface (col 5, lines 48-56);
- b. Configuring the label to provide information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and
- c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the label (col 3, lines 39-42 and col 5, lines 48-59).

While Dlugos does not explicitly disclose that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, Redford discloses a similar method and apparatus of attaching a computer readable medium (optical disk) to an item and further discloses that "on insertion of an optical disk or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media" (page 7, paragraph 0105). Therefore, it would have been obvious to one having ordinary skill in

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the art at the time the invention was made to store computer executable instructions (software) on the computer readable medium attached to the item in Dlugos. One would have been motivated to include software on the disk to display additional information about the item (e.g. operating instructions, troubleshooting, etc.) or to automatically update the item information stored thereon as discussed by Redford or to provide for automatic registration of the item as discussed by Dlugos.

Claims 2, 12, and 19: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the information is printed on the label (col 3, lines 19-23).

Claims 3, 13, and 20: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 2, 12, and 19 above, but do not explicitly disclose that the printed information is contained in a selection of color on the label. Official Notice is taken that it is old and well known within the marketing arts to use color to differentiate between various labels and tags; such as a clothing store using pink hang tags to indicate that the garment's size is Small, light blue hang tags to indicate that the garment's size is Medium, and green hang tags to indicate that the garment's size is Large. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use labels of various colors in Dlugos. One would have been motivated to use labels of different color in order to facilitate quick and easy identification of the product or product manufacturer by the merchant, the shipper, and the customer (e.g. a blue label for a product made by IBM, whose nickname is "Big Blue").

Claims 4, 14, and 21: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above. While Dlugos prefers that the label is the same size and

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shape as a credit card, it is also disclosed that the label "may be of an overall shape or size different from the standard credit card" (col 6, lines 11-23). However, Dlugos does not explicitly disclose using a trademark symbol on the label to identify the product or the source of the product. Official Notice is taken that it is old and

well known within the marketing arts to use trademark symbols to identify both products and product sources; indeed, that is the purpose for registering trademarks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a trademark symbol on the label in Dlugos. One would have been motivated to include a trademark symbol on the label in order to facilitate quick and easy identification of the product and its source.

Claims 5, 15, and 22: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the computer readable medium containing information pertaining to product facts, source facts, data gathering interface, and many other types of information for use by the receiver, sender, and/or shipper (col 9, lines 49-62).

Claim 6: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 1 above, and Dlugos further discloses that the label may be attached in various ways to a wide variety of products (col 5, line 48 - col 6, line 23).

Claim 7: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 6 above, and Dlugos further discloses placing the label onto the product in a manner which protects the label from damage (col 5, lines 48-56).

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Claims 8 and 16: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1 and 11 above, and Dlugos further discloses the label is a hang tag enclosing the computer readable medium (col 5, lines 48-56).

Claims 9 and 17: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1 and 11 above, and Dlugos further discloses that the computer readable medium includes a printed medium or an electromagnetic medium (col 3, lines 19-23 and 39-52).

Claim 10: Moos and Redford disclose an apparatus for attaching product labels as in Claim 9 above, and Dlugos further discloses that the computer readable medium is formatted as a bar code or embedded chip (col 3, lines 12-13, col 4, lines 52-57, and col 4, line 67 - col 5, line 8).

Claim 23: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 18 above. While various methods of attaching the label to the product are disclosed, including inserting the label into a small pouch, using clips or brackets, etc., it is not explicitly disclosed that the opening into which the label is inserted penetrates all the way into the interior of the product. However, it would have been obvious that such a method of attachment could be used, depending upon the actual product, of course. One would have been motivated to use this or other methods to attach the label to the product in order to prevent or reduce the likelihood that the label would become detached during shipping or handling as discussed by Dlugos.

Claim 25: Dlugos and Redford disclose a method for attaching product labels as in Claim 24 above, and Dlugos further discloses that the product is packaged with a "clear plastic film or packing material containing air bubbles" (col 5, lines 49-51).

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Claim 26: Dlugos and Redford disclose a method for attaching product labels as in Claim 24 above, and Dlugos further discloses that the label is attached to the outside of the product using a flexible member (i.e. the label is a tag)(col 5, line 60 - col 6, line 2).

Claims 27 and 28: Dlugos discloses an apparatus for attaching product labels, comprising:

- a. A label affixed to a product surface at the source of the product (col 5, lines 48-56);
- b. Configuring the label to provide advertising information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and
- c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the product by the label (col 3, lines 39-42 and col 5, lines 48-59).

While Dlugos does not explicitly disclose that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, Redford discloses a similar method and apparatus of attaching a computer readable medium (optical disk) to an item and further discloses that "on insertion of an optical disk or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media" (page 7, paragraph 0105). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store computer executable instructions (software) on the computer readable medium attached to the item in Dlugos. One would have been motivated to include software on the disk to display additional information about the item (e.g. operating instructions, troubleshooting, etc.) or to automatically update the item information

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stored thereon as discussed by Redford or to provide for automatic registration of the item as discussed by Dlugos.

It is inherent that since the label in Dlugos is on the outside of the product, it is viewable by the prospective purchaser or anyone else who looks at the product.

(10) Response to Argument

On page 4 of the Appellant's Appeal Brief dated 11/30/2005, Appellant states:

"In the present case, modifying the automatic, wireless interaction of Dlugos to incorporate the manual disk-insertion of Redford would change the principle of operation of Dlugos. Accordingly, the combination of Dlugos and Redford is not sufficient to render claims 1-28 prima facie obvious."

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner further notes that teaching of a preference does not constitute a teaching away from the proposed combination under review. See *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

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references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Additionally, in the MPEP section 716.01(c) under the title “Attorney Arguments Cannot Take the Place of Evidence”, Examiner notes that objective evidence must be presented to prove inoperability.

And, Examiner notes that both Dlugos and Redford each teach both automatic, wireless and manual disk-insertion techniques for transfer of information from a portable medium.

As the Appellant has noted, Dlugos teaches wireless transfer of information:

“(14) Microprocessor 100 is connected through amplifier 118 to sensor 40, Sensor 40 is adapted to sense pulsed or other data communications. The communications may be in the form of infrared, visible light, or other radiation, radio frequency transmissions, or variations in a magnetic field. For example, sensor 40 may take the form of an infrared pin diode input array. Acoustical or ultrasonic communication means are also within the contemplation of this invention. The communications protocol may be ASCII or echoplex or any other suitable protocol” (col 4, lines 28-32).

Additionally, Dlugos teaches both wireless and manual disk-insertion techniques for transfer of information:

“(68) Input and output of data to and from manifest card 2' is accomplished with a terminal 300. Terminal 300 has electrical contacts or transmitting and receiving means, and operates with a communications protocol, that are compatible with the manifest card. Referring to FIG. 11, in a preferred embodiment, terminal 300 is interfaced to a conventional manifesting system 400 (such as the STAR200 Manifesting System available from Pitney Bowes Inc.,

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Stamford, Conn. Manifesting system 400 comprises computer 402, display 404, keyboard 406, scale 408, and bar code scanner 410. Computer 402, display 404 and keyboard 406 can be standard microcomputer components, computer 402 comprising one or more floppy or hard disk drives. Scale 408 can be a conventional electronic scale such as model A-217 available from Pitney Bowes. Scale 408 comprises parcel receiving means 412, which can be a conventional scanner such as model F-117 available from Pitney Bowes. Manifesting system 400 may also comprise one or more printers (not shown) (col 11, lines 40-60).

(69) Terminal 300 comprises slot 420, into which manifest card 2' is inserted for input of data from terminal 300 and output of data to terminal 300. Alternatively, the transmitting and receiving means of terminal 300 and manifest card 2' may be such as are operable when terminal 300 and manifest card 2' are in proximity to each other. In this case, no slot 420 is required (col 11, lines 40-67).

(89) According to another application, when the system of FIG. 11 is operated in a batch mode as described above, a label 2 is inserted into slot 420 of terminal 300 before parcel P is processed. Parcel information generated by computer 402 is input into label 2, which is then attached or reattached to parcel P. Before the next parcel is processed, another label 2 is inserted into slot 420, and the process continues. As described above, all of the manifest data generated by computer 402 or terminal 300 is input into manifest card 2' after completion of processing of the entire group of parcels. (It should be understood that in addition to, or instead of, writing parcel information into label 2, terminal 300 may read parcel information from label 2, which parcel information is then communicated to computer 402 to be used in generating manifest data) (col 14, lines 47-65).

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(90) In another embodiment, the system of FIG. 11 comprises more than one terminal 300. A first terminal 300 is used to write parcel information into, and possibly also to read parcel information from, a label 2 that has been or will be attached to parcel P. A second terminal 300 corresponds to that shown in FIG. 11 and is used for inputting manifest data into manifest card 2', and possibly also for reading manifest data from manifest card 2'. In the latter situation the manifest data read from manifest card 2' is communicated to computer 402, which causes the first terminal 300 to write into a label 2 parcel data based upon that manifest data from manifest card 2' (col 14, line 64-col 15, line 10).

(91) Similarly a terminal 300 standing alone, or in communication with a second terminal 300, may be programmed to (a) read parcel information from a label 2 and input manifest data into a manifest card 2', or (b) read manifest data from a manifest card 2' and input parcel information into a label 2, or (c) perform both (a) and (b)'' (col 15, lines 10-15).

Please particularly note the citation above (col 11, lines 40-67) which states that the card can transfer information wirelessly or via manual disk-insertion techniques.

And, Redford discloses both wireless and manual disk-insertion techniques for transfer of information:

“[0011] For example, touching the content "CHINA AIRLINES" of a card (when mounted on the base) generates a remote control signal that instructs a host device to automatically display electronic content accessible in the form of a page (also called "Web page") on the World Wide Web part of Internet at the address <http://www.china-airlines.com/>. Such electronic content can be held in a storage media that is coupled to the host device by a server, for example, through a public or private network such as a telephone network, a satellite

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network, or a cable network. Alternatively, the electronic content can be held in a storage media that is packaged with the insert, and that is inserted into the host device by the user.

[0105] In one variant of the alternative implementation, an optical disc (such as CD-ROM 544 illustrated in FIG. 5G) is provided by the publisher of a periodical in a holder that is physically attached to the periodical. The user removes the optical disc from the holder and inserts the optical disc into storage media drive 124 in host device 120. On insertion of an optical disc or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media as described in U.S. patent application Ser. No. 08/497,177 incorporated by reference above. Thereafter, when the user assembles and operates remote control 10 (as described herein), host device 120 retrieves from the inserted storage media one or more tables required to identify the selected information and thereafter displays the selected information in response to wireless signal 111, as described in, for example, U.S. patent applications, Ser. No. 08/269,492 and 08/816,616 incorporated by reference above.

[0106] In another variant of the alternative implementation, host device 120 uses a UPC code directly to display on monitor 122 electronic content 13. Specifically, remote control 10 transmits in wireless signal 111, as the identification code, a UPC code, e.g. the number 3224502192 that indicates the book "The Cruise Caper" by Marilyn L. Bollinger, available from Hasboro, Inc., Pawtucket, R.I. 02862. On receipt of the UPC code, host device 120 looks up on server 131 (FIG. 2B) the file 3224502192.HTML. Server 131 is coupled to a storage media, e.g. one of disks 132A-132D on which are stored a number of files each having a UPC code as the file name in a home directory of server 131. Each of the files (not shown in FIG. 2B)

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includes a HTML instruction to redirect the host device 120 to the address of the requested electronic content.

[0111] In an alternative embodiment, host device 120 retrieves electronic content 13 (FIG. 1) from a local storage media, e.g. the above-described optical disc through storage media drive 124. Specifically, host device 120 compares an identification code retrieved from wireless signal 111 with another identification code retrieved from the optical disc to ensure that electronic content 13 associated with the touched printed content is available on the optical disc.

On finding a match, host device 120 displays electronic content 13 that is retrieved from the optical disc. If host device 120 cannot find an identification code from wireless signal 111 in the optical disc, host device 120 displays an error message requesting the user to insert the appropriate disc.

[0112] In yet another embodiment, host device 120 retrieves electronic content 13 from a hard disk 125 (FIG. 2B) in a manner similar to that described above for the optical disc. Specifically, host device 120 compares an identification code retrieved from wireless signal 111 with another identification code retrieved from hard disk 125, to ensure that electronic content 13 is available on hard disk 125. On finding a match, host device 120 displays electronic content 13 that is retrieved from hard disk 125. Electronic content 13 can be stored on hard disk 125, for example by use of software (commonly called "push" software) that retrieves electronic content 13 through Internet periodically and stores the electronic content on hard disk 125. Push software such as POINTCAST is available from, for example, Pointcast Inc., 10101 North De Anza Blvd., Cupertino, Calif. 95014".

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Hence, Redford discloses both wireless and manual disk-insertion techniques for transfer of information.

Since Dlugos discloses both wireless and manual disk-insertion techniques for transfer of information and Redford discloses both wireless and manual disk-insertion techniques for transfer of information, Redford would not render Dlugos inoperable because of manual disk-insertion techniques for transfer of information.

Hence, the Appellant's arguments are not found persuasive.

Hence, the combination of Dlugos and Redford renders obvious the Appellant's claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


A handwritten signature in cursive script, appearing to read "Arthur Duran".

Arthur Duran

Primary Examiner

2/16/2006

Conferees:

Eric Stamber 

Jeff Carlson 